

REMARKS

Continued prosecution and reconsideration of the above-identified application is respectfully requested in view of the amendment above and the discussion that follows.

Claim 13 has been amended. Claims 1-7 and 9-13 are in the case and are before the Examiner.

I. The Amendment

Claim 13 has been amended to make clear the meaning of the claims and specifically to specify "to a receiver unaware of the method for minimizing the peak to average power ratio." Support is found in the specification at page 4 line 21 – page 5 line 2 and at page 5 lines 19-21.

II. Claim Rejections – 35 USC § 103

Claims 9-13 have been rejected under 35 USC § 103(a) as being unpatentable over Tellado, et al. (U.S. Patent No. 6,424,681) in view of Kotzin, et al. (U.S. Patent No. 5,796,722). After a careful review of Tellado et al., Kotzin et al. and the claims, it is believed that the rejections are in error and the rejections are, therefore, traversed.

First, all claim limitations of the present invention are not in Tellado et al. and therefore, the Examiner's reliance on Tellado et al. appears to be mistaken.

MPEP § 2143.03 provides:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Tellado et al. specifically states that the receiver must know about the method to reduce peak to average power ratio. (Tellado et al., col 14 lines 5-21). Specifically, Tellado et al. states "of course, the receiver must know which frequencies are peak reduction frequencies." Id. The claim limitation requiring "a receiver unaware of the method for minimizing peak to average power ratio" is not found in Tellado et al. as required by MPEP § 2143.03. Since Tellado et al. does not teach or suggest a claim limitation of Applicants' claimed invention, the rejection under 35 USC § 103(a) is improper and should be withdrawn.

Second, Tellado et al. must be considered in its entirety, including disclosures that teach away from the claims. For the reasons stated below, the Examiner's reliance on Tellado et al. is mistaken.

MPEP § 2141.02 provides:

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Tellado et al. teaches away from the claimed invention. Tellado et al. teaches of a receiver that must know which frequencies are peak reduction frequencies. Tellado et al., col 14 lines 5-21. Tellado et al. teaches of a receiver that must be modified to have knowledge of which frequencies are peak reduction frequencies. Id. Further, Tellado et al. teaches that the communications to the receiver must include information about the identify of the peak reduction frequencies. Id. In contrast, the claimed invention comprises "a receiver unaware of the method for minimizing peak to average power ratio." Applicants recognize that the prior art has such a limitation and have described in

their specification that “[prior art] methods require that the receiver be aware of he predesignated channels to be used for peak reduction.” Specification, page 3, lines 19-21. Applicants claimed invention has “[t]he advantage … that the receiver need not have prior knowledge of the transmitter employing a PAR reduction mechanism.” Specification, page 4, lines 21-22. In short, the claimed invention comprises “a receiver unaware of the method for minimizing peak to average power ratio” whereas Tellado et al. teaches away from the claimed invention. MPEP § 2141.02 provides that teaching away from a claimed invention is an indicia of unobviousness; thus, the claimed invention is not obvious as stated by the Examiner. Since Tellado et al. teaches away from the claimed invention, the rejection under 35 USC § 103 is improper and should be withdrawn.

Because Tellado et al. is an inappropriate basis for rejection of Applicants’ claimed invention, Tellado et al. in combination with Kotzin et al. is an inappropriate basis for rejection of Applicants’ claimed invention. Thus, the rejection under 35 USC § 103 is improper and should be withdrawn. For all the above reasons, the rejection of Claims 9-13 is believed to be improper and should be withdrawn. Further, allowance of Claims 9-13 is believed to be in order and such action is earnestly solicited.

III. Allowable Subject Matter

Examiner states that Claims 1-7 are allowable. Therefore, the allowance of Claims 1-7 is believed to be in order and such action is earnestly solicited.

SUMMARY

The allowance of Claims 1-7 and 9-13 is believed to be in order and such action is earnestly solicited. The application is believed to be in condition for allowance. An early notice to that effect is earnestly solicited. The Examiner is requested to phone the undersigned should any questions arise that can be dealt with over the phone and expedite this prosecution.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this Reply and Amendment is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231 on February 9, 2004.

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